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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/680,874	10/06/2003	Sharon N. Farrens	18419D-009011US	4386
20350	7590	08/12/2004	EXAMINER PERT, EVAN T	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			ART UNIT 2829	

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/680,874

Applicant(s)

FARRENS ET AL.

Examiner

Evan Pert

Art Unit

2829

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003 (preliminary amendment).
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>0804</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 5-41 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-27 of U.S. Patent No. 6,645,828 and claims 1-8 of US Patent 6,180,496. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are merely obvious variants of the patented claims:

For example, regarding pending claim 5 in view of patented claim 1 in the '828 patent, the "transferring" is a necessary way of "placing" substrates in a chamber because if they are not "transferred" from somewhere, they can not be "placed."

The pending claim 5 includes that the "plasma chamber" is "equipped with a bonding apparatus" while the patented claim does not require a "bonding apparatus" in the "plasma chamber."

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to include a bonding apparatus in the plasma chamber, motivated to place the faces of first and second substrates "without breaking vacuum" in the chamber as recited in the patented claim 1.

As another example, regarding pending claim 15 in view of the patented claim 19, the patented claim merely omits the "removing" the bonded substrates step added to the pending claim.

It would have been obvious to one of ordinary skill in the art to "remove" the bonded substrates from the chamber in patented claim 19 because if the bonded substrates are not removed from the chamber the chamber must remain part of the bonded substrates, which seems ridiculous, but possible to obviate a statutory double-patenting rejection by an ever-so-slightly theoretically-possible difference of scope.

As yet another example, regarding pending claim 5 in view of patented claim 7 of the '496 patent, the pending claim 5 recites that the a bond is initiated by a bonding apparatus in the plasma chamber, but the patented claim only requires that the substrates are bonded "without breaking vacuum."

It would have been obvious to one of ordinary skill in the art at the time of the claimed invention to initiate a bond with a bonding apparatus in the plasma chamber, motivated by the suggestion to put a bonding apparatus in the plasma chamber per step iv of claim 7.

While it seems trivial to "initiate the bond" in step v of the patented claim 7 using the "bonding apparatus" in step iv of claim 7, and almost even necessary, the patented claim 7 does not require it, while pending claim 5 does require using a bonding apparatus in the plasma chamber. It would have been obvious to "initiate a bond" using the bonding apparatus in the plasma chamber, with one being motivated to perform the bond "without breaking vacuum" as claimed in the patents.

While the differences in scope of the pending claims are very trivial, the differences are deemed as meeting a minimum threshold to obviate a statutory double-patenting rejection under 35 USC 101.


Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evan Pert whose telephone number is 571-272-1969. The examiner can normally be reached on M-F (7:30AM-3:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kamand Cuneo can be reached on 571-272-1957. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

ETP
August 6, 2004


EVAN PERT
PRIMARY EXAMINER